

REMARKS/ARGUMENTS

Claims 53-56 are active. Claims 57-63 have been withdrawn from consideration. Non-elected claim 57 now includes the limitations of claim 64, which has been cancelled along with claims 65-70 as superfluous. No new matter has been introduced.

Restriction/Election

The Applicants previously elected with traverse Group I, Claims 1-13, directed to a cinnamic acid containing product (plant growth regulator). At least new Claims 53-56 are directed to such products. The claims of Groups II-IV which are respectively directed to a method of making (II) and method of use (III) for the plant growth regulator, as well as dwarfing plant (IV) have been withdrawn from consideration. Upon an indication of allowability for a claim in the elected Group I, the Applicants respectfully request rejoinder and allowance of non-elected claims which depend from, or otherwise incorporate the limitations of an allowable claim in the elected Group I.

Rejection—35 U.S.C. §103

Claims 53-56 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al., U.S. Patent No. 3,157,964, in view of Kohno, et al., U.S. Patent No. 5,791,084. The Applicants respectfully traverse this rejection because the prior art provides no suggestion or motivation to combine cinnamic acid and tripolyphosphate in the concentrations required by the claims, provide a reasonable expectation of success that this composition would have some utility, or even teach all the elements of the invention.

To establish a *prima facie* case of obviousness, three **basic** criteria must be met. First there must be some **suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference

teachings. Second, there must **be a reasonable expectation of success**. Finally, the prior art reference (or references when combined) must teach or suggest **all the claim limitations**.

Ferguson is non-analogous art and is directed to “Polymeric Compositions and their use for supplying and maintaining plant moisture” (emphasis added, see Title) and does not suggest combining unpolymerized cinnamic acid with tripolyphosphate. Col. 3, lines 22 *ff.* referred to in the Official Action, does not disclose or suggest a solution containing 0.5 to 25 wt.% of cinnamic acid or suggest any use for cinnamic acid other than one of many possible monomers for the preparation of “addition polymers”.

The Official Action does not point out any composition in Ferguson that contains unpolymerized cinnamic acid. The cinnamic acid described in col. 3, lines 26-28 is representative of the various alpha- or beta-ethylenically unsaturated carboxylic acids, which can be employed to make the addition polymers of the Ferguson invention. From the context of col. 3, the expression “can be employed” means “can be polymerized into an addition (co)polymer”. Clearly, there is no disclosure or exemplification of a composition containing cinnamic acid here. However, assuming, for the sake of argument, that Ferguson disclosed an aqueous composition containing cinnamic acid for later polymerization into an addition polymer, there is no disclosure or suggestion to (i) select cinnamic acid (as opposed to the other alpha- or beta-ethylenically unsaturated carboxylic acids), (ii) select a concentration of cinnamic acid between 0.5 to 25 wt.%, or (iii) include 35-300 wt.% of a tripolyphosphate. Furthermore, similar arguments apply should the Ferguson be deemed to disclose a polymerized addition polymer in which there might remain unreacted cinnamic acid monomers, since Ferguson does not suggest use of such a post-polymerization mixture in a nontoxic, aqueous composition without the isolation of the (co)polymer.

With regard to the limitation in claim 53 requiring 0.5 to 25 wt.% cinnamic acid, the Official Action mistakenly asserts that Ferguson teaches various concentrations of cinnamic

acid “depending on the intended plant type”. However, there is no such teaching in Ferguson suggesting the selection of particular concentration of cinnamic acid for such a purpose.

Kohno does not disclose cinnamic acid at all. Thus, neither Kohno nor Ferguson can suggest the combining cinnamic acid and tripolyphosphate as required by the invention, nor provide a reasonable expectation of success for the utility of the invention as a plant growth inhibitor. Moreover, Kohno discloses tripolyphosphate as a “sequestering agent”, see col. 2, lines 10-19, thus teaching away from the present invention, where tripolyphosphate is used as a solubilizer (see e.g., page 9, lines 14-35 of the specification). Kohno uses tripolyphosphates as “sequestering agents” to sever the linkage in a gel so that the gel disintegrates rapidly. One of ordinary skill in the art would have found no motivation in Kohno to combine cinnamic acid and tripolyphosphate as a solubilizer because (1) the function of the sequestering agent as disclosed in Kohno is not to increase cinnamic acid solubility, but is to sever the linkage in the gel, (2) Kohno neither discloses nor suggests that the sequestering agent acts to increase the solubility of cinnamic acid in an aqueous medium, and (3) the aqueous composition disclosed in Ferguson does not contain a gel as described by Kohno. Accordingly, there is no suggestion in either Ferguson or Kohno for combining cinnamic acid and tripolyphosphate.

Moreover, the prior art which does not suggest the claimed composition, cannot provide a reasonable expectation of success for the utility of the claimed cinnamic acid composition to regulate plant growth (or to perform any other useful function). These documents do not disclose or suggest the combination of cinnamic acid and tripolyphosphate and thus are silent with regard to the useful effects of this combination.

Furthermore, the Official Action itself admits that the percentage amounts for both cinnamic acid and tripolyphosphate required by independent claim 29 “are not disclosed by Ferguson, et al. and Kohno et al.” (Official Action, top of page 4). Thus, the prior art does

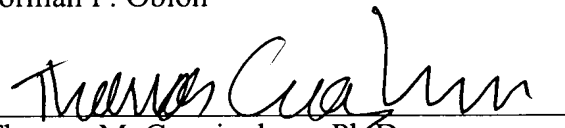
not disclose all the elements or limitations of the invention. Accordingly, for these several reasons, the Applicants respectfully submit that this rejection should now be withdrawn.

CONCLUSION

In view of the above amendments and remarks, the Applicants submit that this application is now in condition for allowance. Early notification to that effect is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

A handwritten signature in black ink, appearing to read "Thomas M. Cunningham", is written over a horizontal line.

Thomas M. Cunningham, Ph.D.
Registration No. 45,394

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)